

S/N 10/614,264
Filed: 07/03/2003
Applicant: Michael S. Rodgers
Examiner: C.Q. Nguyen

REMARKS

Amendments to Specification

The amendments to the specification are to correct misspelled words, such as "tradional" and "reinormcing"; non-sequiter words, such as "larger," "access," "forum," and "with"; and to properly identify element 82 depicted in figure 7, namely a "stub" not a "stud." No new matter is added as a result of these specification amendments.

Amendments to Claims

Claim 1 was amended to correct a spelling error. Applicant respectfully traverses the Examiner's objection to correct the alleged informality in claim 1 regarding the support members. The wording "a plurality of spaced-apart horizontal support members" accurately reflects the Applicant's support member limitation and is similar to the Applicant's support member limitation set forth in Claim 5.

Claim 2 was amended to correct the claim objection asserted by the Examiner and to correct the anticipated no antecedent basis objection/rejection for the fluid concrete limitation.

Claims 3 and 4 were not amended.

Claims 5 and 6 were amended to correct the anticipated no antecedent basis objection/rejection for the "horizontal slab" limitation (claim 5) and fluid lightweight concrete limitation (claim 6).

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Response to Section 102(b) Rejections

Claims 1, 2, 4 through 8 and 10 have been rejected by the Examiner as being anticipated by Graulich (US 5,522,194) pursuant to 35 U.S.C. §102(b). Applicant respectfully submits that the Graulich reference does not disclose all of the claim limitations set forth in claims 1, 2, 4 through 8 and 10. Therefore, the Examiner has failed to make a *prima facie* case of anticipation in this matter.

As stated in MPEP §2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claims.

Turning to the independent claims 1 and 5, the Graulich reference does not expressly or inherently describe the Applicant's "segmented form" or "lightweight concrete." In contrast, the Graulich reference describes a

[A] building panel . . . wherein an insulation board with a lathed outer surface is provided with a reinforcing sheet with substantially large, preferably diamond-shaped openings which is held in spaced relation from the main face of the insulating panel and through which openings concrete may be applied to both sides of the reinforcing material so that the reinforcing material and the vertical channel members and support members and rigidifying members are embedded substantially midway of an exterior coat or bed of concrete.

See Graulich Reference Col. 1 Lines 34 – 45. The Graulich reference discloses a solution for reinforcing a concrete layer applied to the main faces of an

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insulating core, not a segmented form to hold a lightweight concrete slurry. Compare Graulich Reference Col. 1 Lines 26 – 29 with Applicant's Specification, Page 8 Lines 19 - 20.

Furthermore, the structures of the Graulich reference are not arranged as required by the Applicant's claims and do not sufficiently describe the Applicant's invention to have placed the public in possession of it. See *Akzo N.V. v. U.S.I.T.C.*, 808 F.2d 1471, 1479 (Fed. Cir. 1986). Unlike the Applicant's invention, attachment of the concrete reinforcing sheet (10) to the furring channels (5) of the Graulich reference do not create the Applicant's segmented form which *retains* a significant amount of a lightweight concrete slurry until cured. At best the Graulich reference only provides an arrangement to fix a reinforcing sheet *midway* within a cement coating or bed applied to the face of a insulation panel.

The Graulich structures for fixing a reinforcing sheet in the middle of a cement coating or bed to be applied to a insulation panel is not enabling of the Applicant's structures to create a segmented form that retains a significant amount of a lightweight concrete slurry and support it while curing. It is not just a function of how much (or type of) concrete is used to coat the reinforcing screen or fill the segmented form, but the inability of the Graulich elements to perform as the Applicant's support members and retaining layer system. Unlike the Applicant's support members, the furring channels do not make up a frame by which to hold a lightweight cement slurry. While the Graulich furring channels are fixed to a framework of channels (1 and 17) fixed to studs (4), of significance is

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the lack of attachment of the reinforcing sheet to the studs (4) or framework (defined by the channels and studs). Such lack of attachment renders the Graulich elements unable to perform as the elements of the Applicant's invention of simultaneously *retaining* a significant amount of a lightweight concrete slurry and *supporting* it during curing to eventually form a poured-in-place horizontal slab (claim 1) or a poured-in-place wall (claim 5). For these reasons, Applicant respectfully asserts that the Examiner has failed to make a *prima facie* rejection of claims 1 and 5 and further request these claims be allowed.

In addition to the arguments set forth above, which apply equally to the dependent claims 2, 4, 6 through 8, and 10. Applicant respectfully asserts that the specific rejections of claims 2, 4, 6 through 8 and 10 are not supported by the art and should be withdrawn.

With respect to claims 2 and 7, the Graulich reference does not expressly or inherently describe the Applicant's "barrier." The Graulich reference discloses a radiant barrier (18) to increase thermal resistance. See Graulich Reference Col. 2 Lines 35 – 28. Nothing explicit or implicit in the Graulich reference discloses a lightweight cement slurry barrier of claims 2 and 7.

With respect to claims 4 and 10, the Graulich reference does not expressly or inherently describe the Applicant's coverings. The Graulich reference only discloses a cement coating for a reinforcing sheet. See Graulich Reference Col. 1 Line 45.

Turning to claim 6, nothing in the Graulich reference expressly or inherently describes the form wall of the Applicant's invention.

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Finally, nothing in the Graulich reference expressly or inherently described the insulative barrier of Applicant's claim 8. The Graulich reference discloses a *radiant* barrier with a highly reflective surface that overlays the *insulation* board. See Graulich Reference Col. 2, Lines 35 – 38.

For these reasons, Applicant respectfully asserts that the Examiner has failed to make a *prima facie* rejection of claims 2, 4, 6 through 8 and 10 and further request these claims be allowed.

Response to Obviousness Rejections

The Examiner has rejected claims 3 and 9 as being unpatentable over Graulich in view of Egan. Applicant respectfully asserts that the Examiner has failed to make a *prima facie* showing of obviousness in this matter.

To begin, "the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." MPEP § 2142. The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed "as a whole." *Id.* As stated in *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987), "obviousness cannot be established by combining the teachings or the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." In short, the *In re Geiger* decision requires the teachings of combined references, like Graulich/Egan, to be sufficient to justify a conclusion that any proposed modification, such as the use of a insulative material positioned adjacent to the support members and in contact with at least one surface of the lightweight

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concrete, is what one of ordinary skill in the art would have found obvious to do at the time the invention was made. Furthermore, the Court in *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) stated:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . *Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."*

Emphasis added. The Court further stated:

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . *The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. . . . Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not "evidence."*

Id. at 1370. Emphasis added. In short, there must be some logical reason apparent from the evidence of record that would justify a combination or modification of the Graulich/Egan references. See *In re Regel*, 188 U.S.P.Q. 132 (CCPA 1975).

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The Graulich/Egan references do not reveal sufficient teachings, motivation or suggestion (expressly or implicitly) about the positioning of an insulative material adjacent to the support members and in contact with at least one surface of the lightweight concrete to render the Applicant's invention, as claimed in claims 3 and 9, obvious to those of ordinary skill in the art. The Graulich reference is directed at improving the coating of insulative construction panels with cement through the use of a reinforcing sheet and furring channels. See Graulich Reference Col. 1 Lines 25-45. The Egan reference is directed at providing an improved pressure equalized external insulation and finish system through the use of a pressure equalizing compartment. Egan Reference, Col. 1 Lines 10 – 18.

None of the teachings in the Graulich reference teach, motivate or suggest looking to pressure equalizing building component teachings, as set forth in the Egan reference to obviate the Applicant's invention of a poured-in-place lightweight concrete slab or wall that incorporates a segmented form formed from structural members, a retaining layer system and an insulative material. Conversely, nothing within the Egan reference teaches, motivates or suggests looking to the building core panel teachings of Graulich to obviate the Applicant's invention.

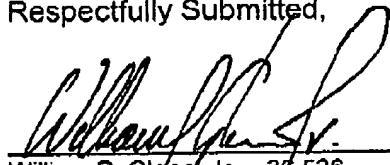
The Graulich/Egan references do not reveal sufficient teachings, motivation or suggestion (expressly or implicitly) about the positioning of an insulative material adjacent to support members and in contact with at least one surface of the lightweight concrete (as set forth in claims 3 and 9). For these

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reasons, Applicant respectfully asserts that the Examiner has failed to make a *prima facie* case of obviousness to reject claims 3 and 9. Therefore, Applicant requests that the rejections be withdrawn and claims 3 and 9 be allowed.

In view of the above amendment and response, Applicant respectfully requests allowance of all the Applicant's claims. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, Examiner is invited to call Applicant's representative at the telephone number shown below.

Respectfully Submitted,



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